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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,987	02/09/2004	Robert C. Schmidt JR.	1927D.BKB	9579

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EXAMINER

CHEUNG, WILLIAM K

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,987

Applicant(s)

SCHMIDT ET AL.

Examiner

William K Cheung

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-13 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-13 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. The examiner acknowledges the receipt of amendment filed November 22, 2004. Claims 11-13, 24-27 are pending.
2. In view of argument filed November 22, 2004, the rejection of Claims 11-12, 26-27 under 35 U.S.C. 103(a) as being unpatentable over Kroll et al. (US 6579915) is withdrawn.
3. In view of argument filed November 22, 2004, the rejection of claims 11, 13, 24-27 under 35 U.S.C. 103(a) as being unpatentable over Yang et al. (US 6,479,126) is withdrawn.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11-13, 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Repp et al. (US 6,128,860).

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*The invention of claims 11-12, 26 relates to an **embossed product** comprising a **cured hot melt adhesive**.*

Repp et al. (Figures 4, 5, 6, and 8, part number 42, 46, 60; col. 8, Table 1; col. 8, line 39-59; col. 9, line 44 to col. 10, line 19) disclose an embossed automotive interior product comprising a cured hot melt adhesive. Repp et al. contain all the limitations of claims 11-13, 26. Claims 11-13, 26 are anticipated.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. Claims 24-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bunch et al. (US 2,596,068).

The invention of claims 24-25 relates to a **casemaking machine** comprising a **curing apparatus**.

Bunch et al. (col. 1, line 1 to col. 2, line 35) disclose a casemaking machine for applying binding material to a back and a pair of cover boards to form a case or cover for loose leaf binders. Because it is well-known that binding material (adhesives) for casemaking industries can be cured using standard casemaking machine, the examiner has a reasonable basis to believe that the claimed "curing apparatus" of claim 24 is inherently possessed in Bunch et al. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

Regarding the claimed "a source of moisture" of claim 25, applicants must recognize that moisture are readily available in air. As soon as the binding material is applied to the case, the moisture curable adhesive would be starting to cure. Therefore, the rejection of claim 25 is proper.

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8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bunch et al. (US 2,596,068) in view of Kroll et al. (US 6579915).

Bunch et al. (col. 1, line 1 to col. 2, line 35) disclose a casemaking machine for applying binding material to a back and a pair of cover boards to form a case or cover for loose leaf binders.

The difference between the invention of claim 25 and Bunch et al. is that Bunch et al. are silent on a casemaking machine comprising a curing apparatus that is the source of actinic or ionizing radiation or a source of moisture.

Kroll et al. (col. 18, line 60-65 and claim 1) disclose the use of radiation curable hot melt adhesive for casemaking. Motivated by the expectation of success of making a case using a radiation curable hot melt adhesive, it would have been obvious to one of ordinary skill in art to incorporate a radiation source such as an actinic or ionizing radiation source to the casemaking machine of Bunch et al. to obtain the invention of claim 25.

9. Claims 11, 26, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins et al. (US 5,806,756) in view of Kroll et al. (US 6579915).

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Jenkins et al. (col. 13-15, claims 1, 5, 8, 9, 10) disclose an embossed box comprising an adhesive.

The difference between the invention of claims 11, 26, 27 is that Jenkins are silent on the specific type of adhesive for the disclosed boxes.

Jenkins et al. (col. 7, line 35-37) clearly state that the disclose box can accommodate different adhesive bonding techniques and capability. Therefore, when Kroll et al. (col. 18, line 60-65 and claim 1) disclose using a radiation curable hot melt adhesive for casemaking, motivated by the expectation of success of making a case using a radiation curable hot melt adhesive and the expectation of an improved adhesive performance (col. 1, line 10-16), it would have been obvious to one of ordinary skill in art to use a curable hot melt adhesive of Kroll et al. into Jenkins et al. to obtain the invention of claims 11, 26, 27.

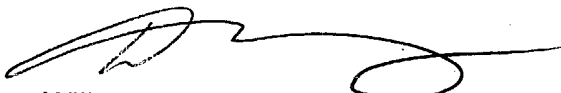
Regarding the claimed "gift box" of claim 27, the examiner has considered the term thoroughly and believe that the recitation "gift" is merely functional language that does not lend itself to patentability because the recited term fail to impart any specific feature to the claimed "box". Any person can use any box as a gift box. Therefore, there is no specific requirement for a "box" to be considered a "gift box".

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung

Primary Examiner

December 3, 2004

WILLIAM K. CHEUNG
PRIMARY EXAMINER